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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,551	02/20/2002	Tatsundo Aoshima	16869N-043900US	4288
20350	7590	11/03/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			POLTORAK, PIOTR	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/081,551	AOSHIMA ET AL.
Examiner	Art Unit	
Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Claims 1-10 have been examined.

Priority

2. Foreign priority has been claimed in this application.
3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/11/01.

Specification

4. The disclosure is objected to because of the following informalities:
 - a. Pg. 3 lines 2-3 recite: "used next is determined by inquiring an numerical value n that indicates how far the password was consumed". "An numerical" should read "a numerical" and "how far the password was consumed" is not understood.
 - b. Pg. 4 line 20 is missing a preposition in the phrase: "service system has accounting information 41 every user to manage the user".
 - c. The phrase: "the applicable number of times n is high" on pg. 6 line 25 is not understood.
5. In the Abstract the phrase: "In response to this, the business system that received the request for use checks the request for use of a commercial service use authority of the user" and the term "nullified" are not understood.
6. Applicant should check the rest of the specification for similar problems.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
8. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. In particular the limitations of claims 4-5 and 9-10 are difficult to follow. As a result, even though the examiner attempts to point out the most obvious issues, applicant should ensure that amended claims are free of ambiguities and antecedent basis problems.
9. The phrase: "checking a commercial service use authority" in claims 1 and 6 is not understood. For purposes of further examination the phrase is treated as checking whether a user is authorized to use the commercial service.
10. The phrase: "checking a commercial service use authority of the user, and returning selects one password ..." in claim 1 is not understood.
11. The term: "nullifying" in claims 1 and 6 is not understood.
12. It is not clear to which part of claims 1 and 6 the phrases "with respect to said commercial service system" and "with respect to the user" are referring.

13. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term.

Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “accounting information” in claims 1-10 is used by the claim language, while the specification on pg. 1 lines 23-25 disclose that applicant really refers to the security (authentication) information. The term is indefinite because the specification does not clearly redefine the term.

14. Claim 4 recites: “... system generates said password list using a numerical value to which an optional numerical value and a one-way function were applied sequentially”. It is not clear whether the claim recites that the numerical value is optional or whether it is applied (sequentially).

15. The phrase: “applicable number of times” in claims 5 and 9-10 is not understood.

16. The terms: “the returned password”, “said used password” (claim 1), “said final result” (claim 4), “the sequentially applied result” (claim 5), “the sequentially applied result” (claim 10) lack antecedent basis.

17. Also it is not clear to which passwords “the password” and “said used password” referrer to.

18. For purposes of examination the claims are treated as best understood. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by *Birrell et al.* (U.S. Patent No. 5805803).

20. As per claims 1 and 6 *Birrell et al.* teach a client computer making a request for a resource. In particular *Birrell et al.* teach checking a checker (141), validating the client and issuing a secure token to the client (Fig. 3 steps 350 and 360). The client (110) sends the secure token and receives the secure resource (Fig. 3 steps 370 and 380).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 2-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Birrell et al.* (U.S. Patent No. 5805803).

22. *Birrell et al.* teach a method as discussed above.

23. As per claims 2-3 and 7-8 *Birrell et al.* do not explicitly teach that the password is generated using a random number. However, using a random number to generate a token for motivation of benefit of increased security is old and well-known in the art (e.g. *Steele et al. U.S. Patent No. 6253325, col. 6 lines 21-23*).
24. *Birrell et al.* also do not teach that the business system sends generated said password list to the commercial service system.
25. However, the limitation is implicit. The business system must send the passwords that are expected to be validated by the commercial system to the place of the commercial system's domain otherwise the commercial system would not be able to verify the passwords.
26. As per claims 4-5 and 9-10 (as *understood*) the limitations call on the password to be derived from a one-way function wherein the one-way function is applied numerous times.
27. Official Notice is taken that it is old and well-known practice to hash passwords (e.g. *Windows NT*). One-way function is the function which produces an output, which not allows to derive an input and as a result one of ordinary skill in the art at the time of applicant's invention would have been motivated to employ hashing passwords in order to increase password security.
28. Hashing the original password several times would be implicit so that following passwords were not the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature

10/14/05
Date


Gregory Morse
SUPERVISORY PATENT
TECHNOLOGY